

ESTTA Tracking number: **ESTTA362742**

Filing date: **08/11/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	The American Legion
Granted to Date of previous extension	08/11/2010
Address	700 N. Pennsylvania Avenue Indianapolis, IN 46204 UNITED STATES
Attorney information	Kimberly A. Eckhart Winston & Strawn LLP 101 California Street San Francisco, CA 94111-5894 UNITED STATES keckhart@winston.com,abridges@winston.com,trademarkssf@winston.com,doctetsf@winston.com Phone:415-591-6805

### Applicant Information

Application No	77864620	Publication date	04/13/2010
Opposition Filing Date	08/11/2010	Opposition Period Ends	08/11/2010
Applicant	Legion Motorcycle Organization LLC, The 5037 Big Red Street Apt. #B Kapolei, HI 96707 UNITED STATES		

### Goods/Services Affected by Opposition


Class 016. First Use: 2009/11/01 First Use In Commerce: 2009/12/26 All goods and services in the class are opposed, namely: Decals; Stickers
Class 021. First Use: 2009/11/01 First Use In Commerce: 2009/12/26 All goods and services in the class are opposed, namely: Mugs; Plates
Class 025. First Use: 2009/11/01 First Use In Commerce: 2009/12/26 All goods and services in the class are opposed, namely: Jackets; Pants; Shirts; Shoes; Sweaters
Class 026. First Use: 2009/11/01 First Use In Commerce: 2009/12/26 All goods and services in the class are opposed, namely: Embroidered patches for clothing

### Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any	Trademark Act section 2(b)

State or municipality, or of any foreign nation, or any simulation thereof	
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3578969	Application Date	02/06/2008
Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	AMERICAN LEGION RIDERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: First Use: 2003/09/00 First Use In Commerce: 2003/11/00 License plate frames</p> <p>Class 014. First use: First Use: 2002/08/00 First Use In Commerce: 2002/11/00 Ornamental pins</p> <p>Class 016. First use: First Use: 2004/05/00 First Use In Commerce: 2004/11/00 Decals; printed certificates</p> <p>Class 020. First use: First Use: 2004/07/00 First Use In Commerce: 2004/11/00 Plastic name tags; plastic key tags; plastic novelty license plates</p> <p>Class 024. First use: First Use: 2003/02/00 First Use In Commerce: 2003/11/00 Nylon flags and nylon banners; flag kits comprising nylon flags and mounting brackets; printed textile labels</p> <p>Class 025. First use: First Use: 2003/07/00 First Use In Commerce: 2003/11/00 Clothing, namely, jackets, shirts, t-shirts, polo shirts, tank tops, sweatshirts, vests; hats, including berets and baseball caps; do-rags</p> <p>Class 026. First use: First Use: 2001/03/00 First Use In Commerce: 2001/11/00 Cloth patches for clothing; belt buckles not of precious metal</p> <p>Class 034. First use: First Use: 2005/08/00 First Use In Commerce: 2005/11/00 Cigarette lighters not of precious metal</p>		

U.S. Registration No.	3661650	Application Date	02/06/2008
Registration Date	07/28/2009	Foreign Priority Date	NONE
Word Mark	US AMERICAN LEGION		

Design Mark	
Description of Mark	The mark consists of an eagle with wings spread, head facing left and a circular emblem over the breast of the eagle containing a wreath, two large rings, two small rings set upon a five-pointed star, rays of the sun in the background and the words "U.S." in the center in its own circle superimposed on the star and "AMERICAN" arched along the top of the circle and "LEGION" arched along the bottom of the circle.
Goods/Services	Class 012. First use: First Use: 2009/04/24 First Use In Commerce: 2009/04/24 License plate frames Class 014. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Ornamental pins Class 016. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Decals; printed certificates Class 020. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Plastic name tags; plastic key tags; plastic novelty license plates Class 024. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Nylon flags and nylon banners; flag kits comprising nylon flags and mounting brackets; printed textile labels Class 025. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Clothing, namely, jackets, shirts, t-shirts, polo shirts, tank tops, sweatshirts, vests; hats, including berets and baseball caps; do-rags Class 026. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Cloth patches for clothing; belt buckles not of precious metal Class 034. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02 Cigarette lighters not of precious metal

U.S. Registration No.	2340046	Application Date	08/04/1998
Registration Date	04/11/2000	Foreign Priority Date	NONE
Word Mark	THE AMERICAN LEGION		
Design Mark	<b>THE AMERICAN LEGION</b>		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1919/00/00 First Use In Commerce: 1919/00/00 ASSOCIATION SERVICES; NAMELY, PROMOTING THE INTERESTS OF PATRIOTISM, COMMUNITY SERVICE, AMERICAN VETERANS, PEACE AND		


	<p>GOODWILL, JUSTICE, FREEDOM, DEMOCRACY AND MUTUAL HELPFULNESS</p> <p>Class 200. First use: First Use: 1919/00/00 First Use In Commerce: 1919/00/00 INDICATING MEMBERSHIP IN AN ORGANIZATION OF VETERANS OF ACTIVE DUTY WARTIME UNITED STATES OR ALLIED (IF A CITIZEN) MILITARY OR NAVAL SERVICE</p>
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U.S. Registration No.	1685652	Application Date	04/13/1990
Registration Date	05/05/1992	Foreign Priority Date	NONE
Word Mark	AMERICAN LEGION US		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1919/00/00 First Use In Commerce: 1919/00/00 association services; namely, promoting the interests of patriotism, community services, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness</p> <p>Class 200. First use: First Use: 1919/00/00 First Use In Commerce: 1919/00/00 indicating membership in an organization of veterans of active duty wartime United States or Allied (if a citizen) military or naval service</p>		


U.S. Registration No.	3593938	Application Date	02/06/2008
Registration Date	03/24/2009	Foreign Priority Date	NONE
Word Mark	THE AMERICAN LEGION LEGACY RUN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02		

	<p>Clothing, namely, t-shirts</p> <p>Class 026. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02</p> <p>Cloth patches for clothing</p> <p>Class 036. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02</p> <p>Charitable fundraising</p> <p>Class 041. First use: First Use: 2007/07/02 First Use In Commerce: 2007/07/02</p> <p>Entertainment services in the nature of an organized motorcycle excursion</p>
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U.S. Registration No.	1692070	Application Date	04/13/1990
Registration Date	06/09/1992	Foreign Priority Date	NONE
Word Mark	SONS OF THE AMERICAN LEGION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1932/00/00 First Use In Commerce: 1932/00/00</p> <p>association services; namely, promoting the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness</p> <p>Class 200. First use: First Use: 1932/00/00 First Use In Commerce: 1932/00/00</p> <p>indicating membership in an association of male descendants of members of the American Legion or of deceased war veterans otherwise eligible for membership in the American Legion</p>		

U.S. Registration No.	1685654	Application Date	04/13/1990
Registration Date	05/05/1992	Foreign Priority Date	NONE
Word Mark	SONS OF THE AMERICAN LEGION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1932/00/00 First Use In Commerce: 1932/00/00</p> <p>association services; namely, providing the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness</p> <p>Class 200. First use: First Use: 1932/00/00 First Use In Commerce: 1932/00/00</p> <p>indicating membership in an organization of male descendants of members of the American Legion or of deceased war veterans otherwise eligible for membership in the American Legion</p>		

U.S. Registration No.	1683334	Application Date	04/13/1990
Registration Date	04/14/1992	Foreign Priority Date	NONE
Word Mark	AMERICAN LEGION AUXILIARY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1921/00/00 First Use In Commerce: 1921/00/00 association services; namely, promoting the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness</p> <p>Class 200. First use: First Use: 1921/00/00 First Use In Commerce: 1921/00/00 indicating membership in an organization of women who are veterans eligible for membership in the American Legion or are related to veterans who are members of the American Legion or who are deceased</p>		

U.S. Registration No.	1685653	Application Date	04/13/1990
Registration Date	05/05/1992	Foreign Priority Date	NONE
Word Mark	AMERICAN LEGION AUXILIARY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1921/00/00 First Use In Commerce: 1921/00/00 association services; namely, promoting the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness</p> <p>Class 200. First use: First Use: 1921/00/00 First Use In Commerce: 1921/00/00 indicating membership in an organization of women who are veterans eligible for membership in the American Legion or are related to veterans who are members of the American Legion or who are deceased</p>		

Attachments	77390452#TMSN.jpeg ( 1 page )( bytes ) 77390503#TMSN.jpeg ( 1 page )( bytes ) 75530423#TMSN.gif ( 1 page )( bytes ) 74048741#TMSN.gif ( 1 page )( bytes ) 77390531#TMSN.jpeg ( 1 page )( bytes ) 74048747#TMSN.gif ( 1 page )( bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kimberly A. Eckhart/
Name	Kimberly A. Eckhart
Date	08/11/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/864620

Filed: November 4, 2009

For the Mark: THE LEGION MC RISING FROM THE ASHES & DESIGN

Published in the Official Gazette on: April 13, 2010<sup>1</sup>

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The American Legion,

Opposer,

v.

The Legion Motorcycle Organization LLC,

Applicant.

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Opposition No. \_\_\_\_\_

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**NOTICE OF OPPOSITION**

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The American Legion, a federally chartered corporation with perpetual existence, created by an Act of Congress that maintains its principal place of business at 700 N. Pennsylvania Avenue, Indianapolis, Indiana 46204, believes that it will be damaged by registration of THE LEGION MC RISING FROM THE ASHES & DESIGN ("Applicant's Mark") for use in connection with "decals; stickers" in International Class 16, "mugs, plates" in International Class 21, "jackets, pants, shirts, shoes, sweaters" in International Class 25, "embroidered patches for clothing" in International Class 26 as set forth in U.S. Trademark Application Serial No.

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<sup>1</sup> On May 7, 2010, The American Legion ("American Legion") filed a request to extend time to oppose. The Trademark Trial & Appeal Board granted the American Legion's request until August 11, 2010.



77/864,620 (the "Application") filed by The Legion Motorcycle Organization LLC (the "Applicant"), and hereby opposes the Application. The grounds for the opposition are as follows:

***The American Legion's Prior Rights.***

1. The American Legion was established on September 16, 1919 as a nationwide wartime veterans' organization and is the United States' largest veterans service organization. As a not-for-profit community service organization, the American Legion is committed to disseminating information to, and educating, the public about veterans affairs and rehabilitation issues as well as raising money and providing support to various other programs including child welfare, scholarships, and emergency relief during natural disasters.


2. Significantly, the U.S. Congress has given the name and emblem of The American Legion special statutory protection. By a special law of the U.S. Congress, the organization has the sole and exclusive right to have and use The American Legion name in carrying out its purposes. In addition, the U.S. Congress has enacted specific criminal penalties against anyone who is found to use the emblems or other insignia of The American Legion. *See* 18 U.S.C. § 705; 36 U.S.C. § 21705. As a result of these protections, anyone who reproduces, sells, or distributes merchandise bearing THE AMERICAN LEGION mark or the organization's emblems must obtain special authorization from The American Legion.

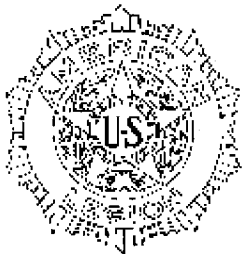
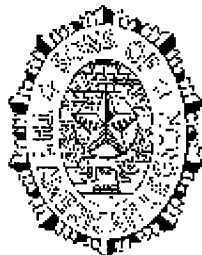
3. Since substantially before to the filing date of the Application, The American Legion has been using, and continues to use, several marks and trade names incorporating the term "LEGION" and/or a bird design in connection with its services and the distribution and sale of merchandise to support The American Legion's activities.


4. The AMERICAN LEGION RIDERS program was started in the fall of 1993 when some members had the idea to start an association of motorcycle enthusiasts within The American Legion. The American Legion's National Executive Committee officially adopted the AMERICAN LEGION RIDERS program as a national program in October 2007. Currently, there are approximately 106,000 AMERICAN LEGION RIDERS members. AMERICAN

LEGION RIDERS chapters are well-known for their charitable work, which raises money for local children's hospitals, schools, veterans homes, severely wounded service members, and scholarships. Sales of AMERICAN LEGION RIDER merchandise including apparel, motorcycle gear, patches, flags, and pins support this charitable work.

5. The American Legion owns several relevant valid, subsisting, uncanceled, and unrevoked U.S. registrations:

Mark (Registration No.)	Filing Date Reg. Date	Goods/Services
AMERICAN LEGION RIDERS  (Reg. No. 3,578,969)	02/06/2008  02/24/2009	Class 12: license plate frames  Class 14: ornamental pins  Class 16: decals; printed certificates  Class 20: plastic name tags; plastic key tags; plastic novelty license plates  Class 24: nylon flags and nylon banners; flag kits comprising nylon flags and mounting brackets; printed textile labels  Class 25: clothing, namely, jackets shirts, t-shirts, polo shirts, tank tops, sweatshirts, vests, hats, including berets and baseball caps; do-rags  Class 26: cloth patches for clothing; belt buckles not of precious metal  Class 34: cigarette lighters not of precious metal
U.S. AMERICAN LEGION & DESIGN    (Reg. No. 3,661,650)	02/06/2008  07/28/2009	Class 12: license plate frames  Class 14: ornamental pins  Class 16: decals; printed certificates  Class 20: plastic name tags; plastic key tags; plastic novelty license plates  Class 24: nylon flags and nylon banners; flag kits comprising nylon flags and mounting brackets; printed textile labels  Class 25: clothing, namely, jackets, shirts, t-shirts, polo shirts, tank tops, sweatshirts, vests; hats, including berets and baseball caps; do-rags  Class 26: cloth patches for clothing; belt buckles

Mark (Registration No.)	Filing Date Reg. Date	Goods/Services
		not of precious metal Class 34: cigarette lighters not of precious metals
THE AMERICAN LEGION (Reg. No. 2,340,046)	08/04/1988 04/04/1988	Class 42: association services, namely promoting the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness
AMERICAN LEGION US & DESIGN  (Reg. No. 1,685,652)	04/13/1990 05/05/1992	Class 42: association services, namely, promoting the interests of patriotism, community services, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness
THE AMERICAN LEGION LEGACY RUN (Reg. No. 3,593,938)	02/06/2008 03/24/2009	Class 25: clothing, namely T-shirts Class 26: cloth patches for clothing Class 36: charitable fundraising Class 41: entertainment services in the nature of an organized motorcycle excursion
SONS OF THE AMERICAN LEGION (Reg. No. 1,692,070)	04/13/1990 06/09/1992	Class 42: association services, namely, promoting the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness
SONS OF THE AMERICAN LEGION & DESIGN  (Reg. No. 1,685,654)	04/13/1990 05/05/1992	Class 42: association services, namely, promoting the interests of patriotism, community service, American veterans, peace and goodwill, justice, freedom, democracy and mutual helpfulness
AMERICAN LEGION AUXILIARY	04/13/1990	Class 42: association services, namely, promoting the interests of patriotism, community service,

Mark (Registration No.)	Filing Date Reg. Date	Goods/Services
(Reg. No. 1,683,334)	04/14/1992	American veterans, peace and goodwill, justice, freedom, democracy, and mutual helpfulness
AMERICAN LEGION AUXILIARY & DESIGN   (Reg. No. 1,685,653)	04/13/1990 05/05/1992	Class 42: association services, namely, promoting the interests of patriotism, community service, American veterans, peace, and goodwill, justice, freedom, democracy, and mutual helpfulness

6. Through common law use, application, and registration of various marks incorporating the term “LEGION” and/or a bird design in connection with the activities of The American Legion, consumers are accustomed to assuming that products bearing the term “LEGION” and/or a bird design originate from The American Legion and that purchases they make of these products support The American Legion’s activities.

7. Through The American Legion's long and widespread use, The American Legion’s marks have become strong and well-known.

***The American Legion Will Be Harmed If Applicant Gains A Registration.***

8. On November 4, 2009, notwithstanding The American Legion’s prior rights, Applicant filed its application to register THE LEGION MC RISING FROM THE ASHES & DESIGN mark (Ser. No. 77/864,620).

9. The American Legion believes, and therefore alleges, The Legion Motorcycle Organization LLC, is a Hawaii limited liability corporation, with its principal place of business at 5037 Big Red St, Apt B, Kapolei, Hawaii 96707-3665.

10. The Application was published in the *Official Gazette (Trademarks)* of the United States Patent and Trademark Office on April 13, 2010. This Opposition is timely pursuant to the

Trademark Trial & Appeal Board's May 7, 2010 order allowing The American Legion until August 11, 2010 to institute an opposition.

11. The dominant portion of Applicant's mark is "LEGION," rendering Applicant's mark similar in appearance, sound and meaning to The American Legion's marks.

12. The dominant portion of the design component of Applicant's mark is a design of a bird, rendering Applicant's mark similar in appearance, sound, and meaning to The American Legion's marks.

13. The products for which Applicant seeks registration are the same, similar, complementary, or related to the products or services provided by The American Legion.

14. Applicant and The American Legion both utilize the term "LEGION" in connection with motorcycle club activities and merchandise.

15. Applicant and The American Legion both utilize a bird design in connection with motorcycle club activities and merchandise.

16. Applicant's and The American Legion's products are marketed and sold to similar customers through the same channels of trade.

17. Applicant's mark is confusingly similar to The American Legion's previously used marks, and if Applicant were allowed to register in connection with the products as set forth in the Application, it would likely cause confusion, deception, and mistake among purchasers concerning the origin, source, ownership, or sponsorship of Applicant's products in violation of 15 U.S.C. §§ 1052(d), 1114(1), 1125(a).

18. If Applicant were allowed to register the mark in connection with the products as set forth in the Application, it may disparage or falsely suggest a connection with The American Legion in violation of 15 U.S.C. §1052(a).

19. The American Legion's marks are inherently and commercially distinctive are famous among the general public, and were famous well before any use of Applicant's mark or the November 4, 2009 filing date of the Application.

20. Given The American Legion's considerable reputation, Applicant's use of its mark has diluted, is diluted, and will likely continue to dilute the distinctive quality of The American Legion's marks in violation of 15 U.S.C. §§ 1063(a), 1125(c). Accordingly, The American Legion will be irreparably damaged by Applicant's registration of THE LEGION MC RISING FROM THE ASHES & DESIGN mark.

21. The American Legion will continue to be irreparably damaged by registration of Applicant's confusingly similar mark. Deficiencies or faults in the quality of Applicant's products are likely to reflect negatively upon, tarnish, and seriously injure the reputation which The American Legion has established for its products and services. This confusion is likely to result in loss of revenues used to support the activities of The American Legion and damage The American Legion's reputation.

WHEREFORE, The American Legion respectfully requests that the Board sustain this Opposition and refuse registration of the mark shown in U.S. application Serial No. 77/864,620.

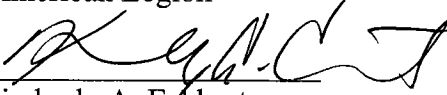
Please charge the requisite filing fee prescribed by 37 C.F.R. § 2.6 (a)(17) to Deposit Account No. 501814 as well as any additional fees due in connection with this Opposition.

Please direct all correspondence relating to this matter to the attorneys for The American Legion at the address shown below.

Respectfully Submitted,

Dated: August 11, 2010

The American Legion

By:   
Kimberly A. Eckhart

WINSTON & STRAWN LLP  
Andrew P. Bridges  
Kimberly A. Eckhart  
101 California Street, 39th Fl.  
San Francisco, CA 94111-5894  
Telephone: 415-591-1000  
Fax: 415-591-1400

Attorneys for Opposer

CERTIFICATE OF SERVICE

re: The American Legion v. The Legion Motorcycle Organization LLC

I hereby certify that a true and complete copy of the foregoing: NOTICE OF OPPOSITION is being served on Applicant The Legion Motorcycle Organization LLC by mailing said copy on August 11, 2010, via First Class, postage prepaid:

The Legion Motorcycle Organization LLC  
Attn: Aaron Hunger  
5037 Big Red St., Apt B  
Kapolei, Hawaii 96707-3665

Executed this 11<sup>th</sup> day of August 2010, at San Francisco, California.

  
Sandi Blanchard